

### **REMARKS/ARGUMENTS**

These remarks are made in response to the Office Action of April 20, 2007 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. Nonetheless, the Examiner is expressly authorized to charge any deficiencies to Deposit Account No. 50-0951.

In the Office Action, Claims 1-7 and 9-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,173,250 to Jong (hereinafter Jong), in view of U.S. Published Patent Application 2004/0049389 to Marko, *et al.* (hereinafter Marko). Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Jong, in view of Marko, and further in view of U.S. Patent 6,339,754 to Flanagan, *et al.* (hereinafter Flanagan).

#### **Informalities in the Claims**

On Page 2 of the Office Action, Claim 11 was objected to for informalities. Applicants thank the Examiner for bringing this error to their attention. Applicants have provided appropriate correction, as suggested in the Office Action. In view of the correction, Applicants respectfully request withdrawal of this rejection.

#### **Applicants' Invention Predates Marko**

Applicants' invention predates the September 10, 2002 filing date of the Marko reference. Applicants conceived of their invention at least as early as April 29, 2002, and actively pursued its reduction to practice from a date prior to the effective date of Marko. In support of this assertion, Applicants submit the Declarations attached hereto. The Declarations provide sworn testimony of Applicants' conception and continuing diligence from a time prior to the filing date of Marko to the filing of the Application.

Along with the Declarations, Applicants also submit herewith a copy of Confidential Invention Disclosure No. BOC8-2002-0056 (Exhibit "A"), titled "Voice-to-Text Reduction for Real Time IM/Chat/SMS" (hereinafter Disclosure). The Disclosure was submitted on April 29, 2002, by Applicants to an intellectual property (IP) professional employed by the assignee of Applicants' invention, International Business Machines Corporation (hereinafter IBM). The Disclosure was insubstantially modified on August 22, 2002. As affirmed in the Declaration, the modifications did not in any way change the actual invention disclosure. As explained below, IBM internal procedures preclude any modification to the description of the invention subsequent to submission to an IBM professional.

The Disclosure explicitly describes Applicants' invention. The written description provided in the Disclosure is clear evidence of Applicants' conception of the claimed subject matter at least as early as August 22, 2002.

The Disclosure is an IBM confidential disclosure form. It is a standardized document that, according to established IBM procedures, is used by IBM inventors to document the conception of an invention. Strictly-followed internal procedures established by IBM govern the use of all such confidential disclosure forms. One aspect of IBM's established procedures governing the use of such confidential disclosure forms is that no substantive modifications can be made to a confidential disclosure after it has been submitted to an IBM Attorney/IP Professional.

The written description, drawings, and each of the claims of the Application were prepared based upon the Applicants' attached Disclosure. Moreover, according to IBM's established procedures governing the use of such disclosures, the Applicants reviewed the Application prior to its submission to the U.S. Patent and Trademark Office in order to ensure that the claims and written description contained therein were fully supported by the Disclosure.

Applicants exercised due diligence from prior to the filing date of Marko to the date that the Application was filed. As expressly affirmed in the Declaration, Applicants from at least April 29, 2002, through the filing of the Application, worked diligently toward a constructive reduction to practice of the invention, first with IBM's own in-house IP professionals, and then with outside counsel retained by IBM to prepare and file the Application.

In further support of Applicants' assertion of diligence from a time prior to preparation of the Application by outside counsel, Applicants also herewith submit the following documents: (1) Exhibit "B" – Post-Disclosure Information provided by Applicants, dated November 12, 2002; (2) Exhibit "C" - a letter asking outside counsel to prepare the Application based on the Disclosure, dated December 26, 2002; and (2) Exhibit "D" - a letter from outside counsel confirming receipt of instructions, dated January 7, 2003.

Outside counsel prepared the Application consistent with long-established professional practices. According to these professional practices, outside counsel prepares applications on a first-in, first-out basis unless a particular application is associated with a bar date; those applications associated with such dates are granted priority within the work queue. Outside counsel followed this professionally-accepted practice in preparing the Application in this case. Applicants diligently cooperated with outside counsel in preparing the Application, promptly responding to requests for review of the Application and requests for providing documents.

Accordingly, in view of the sworn testimony provided and the supporting documents provided herewith, Applicants respectfully submit that Applicants' invention predates the filing date of Marko. Applicants therefore respectfully request withdrawal of Marko as a reference and further submit that all claims are now allowable over the remaining references of record. Moreover, even if Marko were deemed a proper

reference for the present application, the claims still define over the combination of references asserted in the Office Action, as shown below.

**Amendments to the Claims**

Although Applicants assert that Marko is an improper reference, the Applicants have amended independent Claims 1, 11, and 19 to emphasize certain aspects of the claims. In particular, Claims 1, 11, and 19 now include the further limitation that when a text message is converted to an alternative text message, the conversion comprises generating an alternative text message where at least a portion of the original text message is replaced with an alternative text portion having the same meaning but a shorter length. All amendments to the claims are fully supported throughout the Specification. (See, e.g., Specification, para. [0021].) No new subject matter has been introduced by these amendments.

**The Claims Define Over the Cited References**

As previously noted, Claims 1, 11, and 19 were rejected as being unpatentable over Jong in view of Marko. Jong discloses a system and method for speech-text-transmit communications over data networks, including speech recognition components and text-to-speech components. It is acknowledged at page 3 of the Office Action that Jong fails to disclose the compression of text messages prior to their transmission. Such a feature, though, is asserted in the Office Action to be disclosed in Marko. Applicants respectfully submit, however, that Jong, alone or in combination with any other reference of record, fails to disclose each and every element of the claims.

In particular, Jong fails to disclose a system or method for converting the text messages in which at least a portion of the text message is replaced with an alternative text having the same meaning but having a shorter length. Instead, Jong only discloses

providing a translation of the text message into a different language. (See, e.g., Fig. 9 and accompanying text.) Nowhere does Jong disclose or suggest replacing portions of a text message with alternative text portions having the same meaning but a shorter length.

The claims explicitly recite converting text messages into alternative text messages by replacing portions of the text message with portions having the same meaning, but a shorter length (i.e., reduced number of characters). Such a limitation allows reduced-size text messages to be transmitted using typical software compression methods and shorter message lengths. For example, an original text message may state: "hello ... what's going on?" According to the recited method, the portion "what's going on?" can be replaced with a single word "whassup?" This results in the alternative message with the same meaning, "hello ... whassup?" In another example, the original text message may state "Where are you ... it's time to go." According to the recited method, the portion "it's time to go" can be replaced, for example, with the phrase "let's bolt." This results in the alternative message with the same meaning, "Where are you ... let's bolt." In both examples, the alternative text message comprises a text message requiring fewer characters than the original text message. Thus, the shorter text message, along with an appropriate compression technique, results in transmission of a message having a further reduced size without altering the meaning of the original text message. As a result, a lower transmission bandwidth is required, reducing transmission costs for transmitted text messages.

Accordingly, Jong, in combination with Marko or any other reference of record, fails to disclose each and every element of independent Claims 1, 11, and 19, as amended. Therefore, Applicants respectfully submit that Claims 1, 11, and 19 define over the references of record. Furthermore, as the remaining dependent claims depend from one of Claims 1, 11, and 19, while reciting additional features, Applicants

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respectfully submit that the remaining dependent claims likewise define over the references of record.

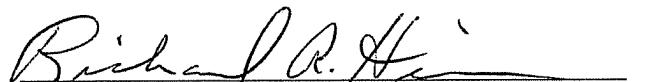
**CONCLUSION**

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants respectfully request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

AKERMAN SENTERFITT

Date: June 20, 2007



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